

Serial No. 09/825,023

Docket No. 1232-4703**REMARKS**

Applicant respectfully requests reconsideration of this application in view of the foregoing amendments and the following remarks.

Claim Status

The Office Action indicates that claims 1-11 are pending in this application and have been rejected. Claims 1, 2, 6, 7, and 11 are herein amended. Of these claims, claims 1, 6, and 11 are independent in form. No new matter has been added by the amendments presented herein.

The 35 U.S.C. §102(e) Rejection

The Office Action rejects claims 1-11 under 35 U.S.C. §102(e) as allegedly being anticipated by US Patent No. 6,650,440 to Wing ("Wing"). For at least the reasons set forth below, Applicant respectfully traverses this rejection and submits that Applicant's claimed invention is patentably distinct over Wing, individually or in combination with the prior art of record.

Wing relates to apparatus and method for reducing facsimile (fax) transmission status outcalls by a sending Fax-to-SMTP gateway to a sending fax device upon the sending gateway receiving responses to at least two confirmation request messages. More specifically, a sending Fax-to-SMTP gateway receives a particular fax message from a sending fax and prepares an email message having attached thereto the particular fax message, and transmits the prepared email message along with first and second confirmation requests (e.g., a DSN confirmation request and a MDN confirmation request) to a receiving gateway device through one or more mailer devices. The first confirmation request corresponds to a first response and

Serial No. 09/825,023**Docket No. 1232-4703**

the second confirmation request corresponds to a second response. Upon receipt of a first response to the first confirmation request, the sending gateway device awaits a predetermined length of time for a response to the second confirmation request, and upon receipt of a response to the second confirmation request, the sending gateway device places an outcall to the sending fax device. According to Wing, because the sending gateway does not place separate outgoing calls for each confirmation request, but rather places a single outgoing call a predetermined time after receiving the first confirmation request (or after receiving the second confirmation request), multiple outcalls for confirming the status of the fax message transmission are avoided, thereby reducing costs to the sending fax user and further reducing the likelihood of confusion and logistic problems to the sending fax user.

With respect to independent claims 1, 6, and 11, Applicant has amended each of these claims to further clarify that "the signal transmission timing is controlled to transmit the signal at a time that prevents a transmission delay via said IP network from causing a corresponding delay in signaling over said general switched telephone network such that the corresponding delay would prevent normal facsimile communication." By way of non-limiting example, in accordance with an illustrative embodiment of the present invention as described in the specification, if an outgoing side Internet facsimile gateway apparatus does not receive a signal from a respective incoming side Internet facsimile gateway apparatus within a prescribed time after receiving a preceding signal, then the outgoing side Internet facsimile gateway will transmit a local signal to the sending facsimile within the prescribed time to ensure normal facsimile communication. See, e.g., Fig. 3, and corresponding description.

Wing, however, does not teach or suggest, *inter alia*, controlling the timing of signal transmission by an Internet facsimile gateway over a general switched telephone network

Serial No. 09/825,023

Docket No. 1232-4703

to secure normal facsimile communication even in the case of one or more IP network transmission delays that would cause a corresponding delay in signaling over said general switched telephone network such that the corresponding delay would prevent normal facsimile communication, as claimed by Applicant (i.e., claims 1, 6, and 11). In contradistinction, as described above, after receiving a first confirmation request response (a DSN request response), Wing's sending gateway waits a predetermined time to receive a second confirmation request response (an MDN confirmation request response) before generating an outgoing call to the sending facsimile to inform the sending facsimile of the confirmation request response. Wing's delay in generating the outgoing call is not controlled such that it "prevents a transmission delay via said IP network from causing a corresponding delay in signaling over said general switched telephone network such that the corresponding delay would prevent normal facsimile communication" at least insofar as the confirmation request response information in Wing—and any delay in the sending gateway receiving it via the mailers—neither affects nor prevents normal facsimile communication. Applicant further respectfully notes that Wing is simply inapposite with respect to Applicant's claimed invention at least inasmuch as Wing is clearly not concerned with controlling an Internet facsimile gateway to ensure normal facsimile communication, but rather is focussed on reducing the number of outgoing status calls made by the sending gateway to the sending fax device upon receiving confirmation request responses.

For at least the foregoing reasons, Applicants respectfully submit that claims 1, 6, and 11 are each patentably distinct over Wing, and that the §102(e) rejection should be withdrawn.

Serial No. 09/825,023

Docket No. 1232-4703

Dependent Claims

Applicants believe that the claims dependent on independent claims 1 and 6 are allowable for at least similar reasons set forth above for the independent claims from which they depend. As such, Applicants have not individually addressed the rejection of these dependent claims. Applicants maintain, however, that these dependent claims recite limitations that provide additional and independent bases for patentable distinction over the prior art of record, and Applicants reserve the right to address such rejections and present such grounds for patentability should such be appropriate and/or necessary. For instance, with respect to claims 2, 4, 7 and 9, Applicant respectfully submits that Wing does not disclose or suggest providing a “pseudo signal” as claimed by Applicant at least insofar as the signal transmitted by the gateway to the facsimile device in Wing is always the *actual* message—either the MDN response or the DSN message—received by the gateway. See, e.g., Wing at col. 12, ll. 23-35.

Conclusion and Authorization

Based on the foregoing, Applicant respectfully submits that claims 1-11 as presented herein are allowable over the prior art of record, taken alone or in combination, and that the application is hereby placed in condition for allowance, which action is respectfully requested.

Applicant believes that the petitioned extension of time is sufficient to render this filing timely. However, should an additional extension of time be necessary, such is hereby petitioned, and the Commissioner is hereby authorized to charge any additional fees which may be required for this paper, or credit any overpayment, to Deposit Account No. 13-4500, Order No. 1232-4703.

Serial No. 09/825,023

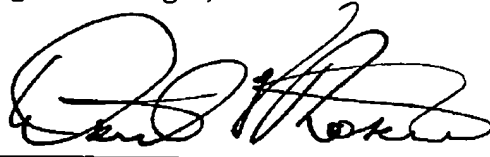
Docket No. 1232-4703

In the event that a telephone conference would facilitate prosecution, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,
Morgan & Finnegan, LLP

Dated: April 4, 2004

By:


David V. Rossi
Registration No. 36,659

Correspondence Address:

Morgan & Finnegan, LLP
3 World Financial Center
New York, New York 10281-2101
(212) 415-8700 (Telephone)
(212) 415-8701 (Facsimile)